

REMARKS

Upon entry of the foregoing amendments, claims 1-31 are pending in this application. In the Office Action dated October 9, 2003, claims 1 and 13 were objected to as having insufficient antecedent basis for limitations therein, claims 24-27 were rejected as being indefinite, and claims 1-27 were rejected in view of the prior art. With this reply, claims 1 and 13 have been amended to provide sufficient antecedent basis, claim 24 has been amended to particularly point out and distinctly claim the subject matter regarded as the invention, and independent claim 1 has been amended to more clearly distinguish the cited prior art. Further, claims 1, 8, 10, 12, and 24, have been amended to correct grammatical errors. In addition, new claims 28-31 have been added. A detailed listing of all claims that are in the application is presented, with an appropriate defined status identifier. Applicant respectfully requests favorable reconsideration of the pending claims in view of the foregoing amendments and the reasons that follow.

1. Claim Objections

In the Office Action, claim 1 was objected to as having insufficient antecedent basis for the limitation "the server," and claim 13 was objected to as having insufficient antecedent basis for the limitation "the data structure." Claim 1 has been amended to recite "message processing system" instead of "server" and claim 13 has been amended to recite "complaint message" instead of "data structure." Accordingly, it is respectfully submitted that the objections to claims 1 and 13 be withdrawn.

2. Claim Rejections – 35 U.S.C. § 112

In the Office Action, claims 24-27 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which Applicants regard as the invention due to the phrase "such as" in independent claim 24. Independent claim 24 has been amended to recite "the" occupant instead of "such as" occupant. Accordingly, it is respectfully submitted that the rejection of claim 24 be withdrawn. In addition, because claims 25-27 are dependent from claim 24, it is further submitted that the rejection to dependent claims 25-27 be withdrawn as well.

3. Claim Rejections – 35 U.S.C. § 103

In the Office Action, claims 1-27 were rejected in view of the prior art under 35 U.S.C. § 103(a). Each specific rejection is addressed below.

3.1 Rejection of claims 1 and 4-10 under 35 U.S.C. 103(a) based on Narasimhan et al. in view of Henson.

In the Office Action, claims 1 and 4-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,073,165 to Narasimhan et al. in view of U.S. Pat. No. 6,167,383 to Henson. As explained below, the cited combination of references fails to disclose the claimed invention, particularly as now amended.

Independent claim 1 recites an “apparatus by which an occupant of a building submits a complaint,” and has been amended to clarify the complaint as “regarding an environmental condition of the building.” Narasimhan discloses a general purpose e-mail message processing and forwarding system. The system in Narasimhan receives e-mail messages at a first location, processes the messages, and then forwards the messages to the intended recipients at remote locations. Narasimhan has nothing to do with a facility management system, and particularly not with managing complaints regarding environmental conditions (e.g., the temperature is too hot/cold, the humidity is too low/high, the lights are too low/high, etc.) in a building controlled by the facility management system (as required by independent claim 1, as amended). Although the Office Action asserts that the system in Narasimhan could be used by occupants of a building to submit complaints to building management, Applicant is unable to find any disclosure or suggestion in Narasimhan to use the system in this way. As noted in the MPEP, “the fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” (See MPEP § 2112) (emphasis original). Hence, it is respectfully submitted that any such use of the system in Narasimhan (assuming such use is even possible) is based on hindsight reconstruction of Applicant’s invention rather than any disclosure or suggestion in the reference itself.

Moreover, the system in Narasimhan would be unsuitable for managing complaints regarding environmental conditions, even if modified in view of Henson. Claim 1 recites that “complaints” regarding an “environmental condition of the building” are submitted by “building occupants” and used to generate a warning that is displayed to “building management” responsible for regulating the environment. As noted above, Narasimhan is simply a general purpose e-mail forwarding system that receives e-mail messages intended for numerous recipients at a first location, processes the messages, and then forwards the messages to the intended recipients at different (remote) locations. In Narasimhan, the senders of the messages are not disclosed or suggested as being “building occupants”; the recipients are not disclosed or suggested as being “building management”; and the messages are not disclosed or suggested as being “complaints,” and especially not complaints “regarding an environmental condition of the building” (all of which limitations are required by claim 1).

As to Henson, the Office Action found it is “in the same filed[sic: field] of electronic commerce and sending messages to the user while shopping online.” Applicant does not understand how this finding (even if accurate) renders Henson applicable to the present invention. The present invention has nothing to do with electronic commerce or sending messages to on-line shoppers, but instead deals with managing complaints regarding environmental conditions in a building.

Assuming for argument Henson is applicable, however, the Office Action cited it for “generating a warning when the received complaint messages satisfy the predefined message filtering criterion.” More specifically, the Office Action stated that it would be obvious to modify Narasimhan in view of Henson “because it helps the system to notify and present the adverse situation to *the users*, as explicitly demonstrated in Henson, so that *the users* can take necessary action to redress the adverse situation” (emphasis added). The foregoing text (and particularly the highlighted portions) evidence a fundamental difference between the cited references as combined in the Office Action and the invention of claim 1. In particular, claim 1 requires that the building occupants (i.e., what the Office Action calls “users”) submit complaints regarding environmental conditions, which result in warnings being displayed to the building management responsible for addressing the adverse situation. By contrast, one

skilled in the art reading Henson would be motivated (according to the Office Action) to modify Narasimhan so that *the users* (i.e., the senders of the complaints) are notified of the complaints so they can address the adverse situation. Assuming this conclusion is correct, this is a teaching away from the invention of claim 1 which requires that the warnings be displayed not to the building occupants that sent the complaints but instead to building management. Accordingly, it is respectfully submitted that independent claim 1 and dependent claims 4-10 are patentable over the cited combination of references for at least the foregoing reasons.

Moreover, a number of the dependent claims are patentable over Narasimhan in view of Henson for independent reasons. For example, claim 7 recites that “the message processing system inhibits generation of a warning when a plurality of complaint messages are received from the same occupant within a predefined interval of time.” In the Office Action, claim 7 was rejected by reasoning that this “is a rule-based scheme and Narasimhan teaches the same.” Applicant respectfully asserts that it is not proper to reject claim 7 (which recites a specific rule for filtering messages) simply on the grounds that it is a rule-based system and Narasimhan also discloses a rule-based system. If the mere knowledge of a general concept (e.g., using a rule-based system for processing messages) in the prior art were sufficient to render all specific instances of that general concept (e.g., suppressing warnings when a plurality of complaints are received from the same occupant within a short period of time) unpatentable, few if any patents would ever be granted. This is not the standard for patentability and never has been. Instead, a proper rejection of claim 7 for obviousness must be based on a disclosure or suggestion in the prior art to provide the specific processing rule recited in claim 7 (namely, suppressing warnings when a plurality of complaints are received from the same occupant within a short period of time). Absent such a disclosure (either inherent or express) in the prior art, the rejection for obviousness is improper and must be withdrawn.

As additional examples, claims 5 and 6 recite that the message filtering used to decide when a warning should be generated to building management is based on “a class of occupants” (recited in claim 5) and a “given area of the building” (recited in claim 6) from which the complaint is received. In the Office Action, these two claims were rejected by

reasoning that a “message from a particular individual or on a particular subject or any combination of such criteria covers the limitations of messages specifying an occupant characteristic or an occupant from a specified class or from a given area of the building.”

Applicant respectfully asserts that this is not a sufficient justification to reject the claims for obviousness. In Narasimhan or Henson there is simply no disclosure, teaching or suggestion to distinguish between messages sent from one “class of occupants” in the building as opposed to another, or from a building occupant in one “given area of the building” as opposed to another. Absent any such specific disclosure or suggestion in the references, the rejection for obviousness must be withdrawn.

3.2 Rejection of claims 2 and 3 under 35 U.S.C. 103(a) based on Narasimhan et al. in view of Henson and in further view of Perkowski.

In the Office Action, claims 2 and 3 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,073,165 to Narasimhan et al. in view of U.S. Pat. No. 6,167,383 to Henson as applied to claim 1 and in further view of U.S. Pat. No. 5,918,214 to Perkowski. As stated above, the combination of Narasimhan in view of Henson fails to disclose or suggest the subject matter of claim 1 (and hence dependent claims 2 and 3), particularly as now amended. As to Perkowski, it fails to make up for the above-noted deficiencies in Narasimhan and Henson for the reasons provided below.

Perkowski is directed to a system and method for finding product and service related information on the Internet. In the Office Action, Perkowski was found to be “in the same field of electronic commerce and analyzing the digital data collected in a database.” As with Henson, Applicant does not understand how this finding (even if accurate) renders Perkowski applicable to the present invention, which has nothing to do with electronic commerce.

Assuming for argument Perkowski is applicable, however, it still fails to disclose or suggest what the Office Action says it does. In the Office Action, Perkowski was said to disclose message filtering criterion which “specifies a given number of *complaint* messages which must be received in order for a warning to be generated” (emphasis added), and that “Perkowski *explicitly teaches* the use of frequency of *complaints* and a defined interval of

time during which the requests are received as the filtering criteria” (emphasis added).

However, Applicant has carefully reviewed Perkowski and is unable to find any disclosure or suggestion therein regarding “complaints,” and particularly not of filtering based on the “frequency of complaints.” Instead, what the Office Action appears to be referring to (based on the citation provided) is the number of “requests for product or service” (i.e., “hits”) received. It is respectfully submitted that this falls far short of a disclosure or suggestion to filter messages based on the number of complaints, as required by claims 2 and 3.

Accordingly, it is respectfully submitted that dependent claims 2 and 3 are patentable over the cited combination of references for at least the foregoing reasons, in addition to being dependent on claim 1.

3.3 Rejection of claims 11-16 under 35 U.S.C. 102(e) based on Narasimhan et al. in view of Official Notice.

In the Office Action, claims 11-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,073,165 to Narasimhan et al. in view of Official Notice. The Official Notice taken was that “both the concept and benefits of a web site and use of web pages while communicating on an Intranet or Internet for the obvious reasons of web pages and web site being a user-friendlier interface for displaying data and for further linking to other web pages and web sites.” As explained below, the cited combination of references fails to disclose the claimed invention.

In the Office Action, Narasimhan was asserted to disclose “an apparatus by which the occupants submit complaints regarding an operating condition of the building (see at least col. 1, lines 39-55 . . .)”, “a storage device containing a log for complaints received from the occupants (see at least col. 3, lines 10-20 . . .)”, and “a workstation coupled to the storage device to obtain and present information from the log to building management personnel (see at least col. 3, line 61 – col. 4, line 11, and col. 4, lines 58-62)”. As explained above, however, Narasimhan is simply a general purpose e-mail message forwarding system. It has nothing to do with managing complaints, and particularly not managing complaints from occupants of a building regarding environmental conditions in the building. Moreover, Narasimhan fails to disclose or suggest a system that provides complaints to building management responsible for resolving the complaints. Since the Official Notice was taken

only for the use of web pages on the Internet as a means of communication, it fails to make up for the above-noted omissions in Narasimhan. Accordingly, Narasimhan in view of the Official Notice (even if correct) fails to render the claimed invention obvious. Hence, it is respectfully submitted that independent claim 11 and dependent claims 12-16 are patentable over the cited combination of references for at least the foregoing reasons.

3.4 Rejection of claims 17-19 and 22-23 based on Narasimhan et al. in view of Official Notice and in further view of Henson.

In the Office Action, claims 17-19 and 22-23 were rejected as being unpatentable over U.S. Pat. No. 6,073,165 to Narasimhan et al. in view of Official Notice as applied to claim 11, and in further view of U.S. Pat. No. 6,167,383 to Henson. As explained above, neither Narasimhan nor the Official Notice discloses or suggests the subject matter of claim 11. Further, the Office Action states that “the limitations recited in dependent claims 17-19 and 22-23 are covered by the limitations recited in claims 1 and 4-7 and are therefore analyzed and rejected as unpatentable over Narasimhan in view of Official Notice and further in view of Henson on the basis of same rationale.” Accordingly, dependent claims 17-19 and 22-23 are patentable over the cited combination of references for at least the reasons cited above with regard to claims 1 and 4-7.

3.5 Rejection of claims 20 and 21 based on Narasimhan et al. in view of Official Notice, further in view of Henson, and further in view of Perkowski.

In the Office Action, claims 20 and 21 were rejected as being unpatentable over U.S. Pat. No. 6,073,165 to Narasimhan et al. in view of Official Notice as applied to claim 11, and in further view of U.S. Pat. No. 6,167,383 to Henson and U.S. Pat. No. 5,918,214 to Perkowski. As explained above, neither Narasimhan nor the Official Notice discloses the subject matter of claim 11. Further, the Office Action states that “the limitations recited in dependent claims 20-21 are covered by the limitations recited in claims 2 and 3 and are therefore analyzed and rejected as unpatentable over Narasimhan in view of Official Notice, further in view of Henson, and further in view of Perkowski on the basis of same rationale.” Accordingly, dependent claims 20 and 21 are patentable over the cited combination of references for at least the reasons cited above with regard to claims 1 and 2-3.

3.6 Rejection of claims 24-27 based on Narasimhan et al. in view of Official Notice, and further in view of Henson.

In the Office Action, claims 24-27 were rejected as being unpatentable over U.S. Pat. No. 6,073,165 to Narasimhan et al. in view of Official Notice, and in further view of U.S. Pat. No. 6,167,383 to Henson. The Office Action stated that, “[r]egarding claim 24 all the limitations are covered in claims 11, and 17 above and are therefore analyzed and rejected as unpatentable over Narasimhan in view of Official Notice and further in view of Henson on the basis of same rationale.” Accordingly, independent claim 24 is patentable over the cited combination of references for at least the reasons cited above with regard to claims 11 and 17. Additionally, it is further submitted that dependent claims 25-27 are patentable over the cited combination of references as they add further limitations to a patentable base claim.

4. Further Amendments

Claims 1, 8, 10, 12, and 24, have been amended to correct grammatical errors as follows. Claim 1 has been amended to recite “occupant” instead of “occupants.” Claim 8 has been amended to recite “comprises” instead of “comprising.” Claim 10 has been amended to add a space between “claim 1” and “wherein.” Claim 12 has been amended to recite “the” before workstation. Claim 24 has been amended to recite “and further applying” rather than “the complaint agent applies,” and to recite “the” before “received complaint messages.”

5. New Claims

With this Amendment, new dependent claims 28-31 are added, which are fully supported by the specification and contain no new matter. Claims 28 and 29 depend variously from and add further limitations to independent claim 1. Claim 30 depends variously from and adds further limitations to independent claim 11. Claim 31 depends variously from and adds further limitations to independent claim 24. Thus, claims 28-31 are patentable for at least the same reasons as their respective base claims.

In addition, claims 28-31 are patentable for independent reasons. For example, claim 28 recites that the apparatus of the respective base claim (and any intervening claims) further comprises “a building control system server coupled to the communication network to obtain

information related to the complaint messages regarding the environmental condition of the building from the facility management system.” Claims 30 and 31 recite similar limitations. None of Narasimhan, Henson or Perkowski disclose or suggest an apparatus connected to a communication network that allows building occupants to submit complaints regarding environmental conditions of the building to building management, wherein a BAS server is connected to the communication network and provides information from the BAS system to the building management along with the complaint. Accordingly, new claims 28-31 are patentable over all of the cited prior art references taken in any combination.

6. Conclusion

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of

papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R.
§1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date January 7, 2004

By David J. Bates

FOLEY & LARDNER
777 East Wisconsin Avenue, Suite 3800
Milwaukee, Wisconsin 53202-5306
Telephone: (414) 297-5760
Facsimile: (414) 297-4900

David J. Bates
Attorney for Applicant
Registration No. 39,902